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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/835,915      | 04/16/2001  | Scot A. Reader       |                     | 5464             |

7590  
Scot A. Reader, P.C.  
1320 PEARL STREET  
SUITE 228  
BOULDER,, CO 80302

03/24/2006

EXAMINER

HAMILTON, LALITA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/835,915  | <b>Applicant(s)</b><br>READER, SCOT A. |  |
|                              | <b>Examiner</b><br>Lalita M. Hamilton | <b>Art Unit</b><br>3624                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08302001</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyer (6,879,990).

Boyer discloses a method and corresponding system for identifying potential patent licensees comprising identifying a first entity, identifying one or more classes in which the first entity has patent assets, identifying or not a second entity as a licensing target in function of a determination of patent assets the second entity has in the one or more classes (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); method is performed in a networked computing environment (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); identifying or not the second entity as a licensing target in function of whether or not, respectively, the second entity has patent assets in the one or more classes (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); the third identifying step includes identifying or not the second entity as a licensing target in function of whether or not, respectively, the second entity has at least a user determined threshold of patent assets in the one or more classes (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); first and second entities include respective families of affiliated companies (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); identifying a first entity and

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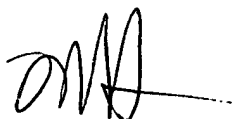
an overlap threshold, and identifying or not a second entity as a licensing target in function of the result of a comparison of an overlap factor with the overlap threshold, wherein the overlap factor is calculated in function of technological overlap between patent assets of the first entity and patent assets of the second entity (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); the technological overlap is defined in function of the number of patents owned by the second entity having a patent classification common to a patent owned by the first entity (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); the technological overlap is defined in function of the percentage of patents owned by the second entity having a patent classification common to a patent owned by the first entity (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); the second entity is identified as a licensing target if the comparison indicates at least a predetermined threshold of technological overlap, and is not identified as a licensing target if the comparison indicates less than the predetermined threshold of technological overlap, wherein identifying or not a second entity as a licensing target in function of a the predetermined threshold is user determinable (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all); and second technological overlap is greater than the first technological overlap (col.2, line 25 to col.3, line 17; col.6, line 65 to col.8, line 45; and fig.7—all).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be the initials 'LMH' followed by a horizontal line.

LMH